



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/018,089 | 12/14/2001 | Christian Leriche | 032326-179 | 6132 |

21839 7590 02/03/2003

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

GORR, RACHEL F

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1711

DATE MAILED: 02/03/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,089

Applicant(s)

LERICHE ET AL.

Examiner

Rachel Gorr

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 20 and 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1711

1. Claims 6 and 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is confusing because it isn't understood how a composition could comprise 100 wt. % copolymer when the preceding claim specifies the presence of ions in addition to the copolymer.

Claims 9-14 provide for the use of a copolymer, but, since the claims don't set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 9-14 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1711

3. Claims 1-4, 6, 7, 9, 11, 12 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Boustta.

Boustta discloses the copolymer of the claims with a degree of polymerization of 20-300 (see structure I, col. 1) and he discloses compositions comprising zero wt. % starch. He discloses salts of the polymer (col. 6, line 46) and teaches the use of the copolymer as an adhesive (col. 6, line 49). In col. 6, line 61, he shows compositions of the copolymer with drugs.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boustta.

6. Boustta discloses the invention of the claims (see above rejection). He differs from the claims by not specifically disclosing the additives of claim 8.

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an antioxidant additive, such as vitamin E, in the compositions of Boustta to act as a preservative for the drug/copolymer compositions to maintain stability.

8. Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Waki.

Waki discloses copolymers made from citric acid and diisocyanate compounds (see example 4 and col. 3, lines 28-32). He discloses using the copolymer as an adhesive (col. 1, line 10).

9. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waki.

10. Waki discloses the invention of the claims (see above rejection). He teaches using his copolymer for coating wires, films and laminated sheets (col. 7, lines 6-7). Waki differs from the claims by not disclosing the specific applications of the claims.

11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Waki's copolymer for coating the electronics in smart cards and electronic labels because Waki teaches using his copolymer for insulating wires (col. 1, line 9) and he shows using his coating for making laminated sheets, which would be printable.

12. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kud, Blair or Tariyama (EP682).

Kud discloses, in claim 1, making polyesters from citric acid and polyhydric alcohols and/or dicarboxylic acids.

Blair discloses, in example 8, making a copolymer from citric acid and a diisocyanate.

Tariyama discloses, in example 10, a copolymer made from citric acid, ethylene glycol, succinic acid and hexamethylene diisocyanate.

Art Unit: 1711

13. Claims 1, 2, 5 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Warzelhan.

Warzelhan (WO173) discloses the copolymer of the claims. The U.S. reference will be used in this rejection, but it's the equivalent of PCT WO96/15173, which was published in 1996. In the abstract, he shows a copolymer made from adipic acid (a1), a diol (a2) and compound D, which is citric acid (col. 3, line 30). It's been held as not being judicious to choose one from a single list (In re Wiggins, 179 USPQ 421). He discloses blending this copolymer with starch and he shows using it as an adhesive (col. 2, lines 39-40). In col. 11, line 39, he teaches using it for making toys.

14. Claims 20 and 21 are objected to for depending on rejected claims.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel Gorr whose telephone number is (703) 308-3608. The examiner can normally be reached on Mon., Tues., Thurs., Fri., from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

R.J.
January 30, 2003


RACHEL GORR
PRIMARY EXAMINER